

REMARKS

These Remarks and the accompanying Amendment are intended to reflect the substance of the 4/7/2004 telephone conference between Examiner Deanna Draper and Attorney Paul Rooy. As agreed in that conference, claims 2, 9, and 16 have been cast in independent form, incorporating all the limitations of their base claims. As a result of the adjunct amendments, it is anticipated that these claims are now in condition of allowability. Arguments are advanced in support of the allowability of claims 1, 8 and 15. An affidavit is herewith submitted in support of the Remarks below. In addition, a \$339 check to "Commissioner for Patents" is herewith submitted: \$210 for response within the second month, plus \$129 for the extra three independent claims.

The following remarks are directed to Page 2, Par. 1 of the Office Action mailed 11/13/2004:

Noted.

The following remarks are directed to Page 2, Par. 2 of the Office Action mailed 11/13/2004:

It is customary to commence the Abstract with a sentence fragment descriptive of the invention. Sample abstract (1) in the Manual of Patent Examining Procedure § 608.01(b) commences with such a fragment. Therefore, as agreed during the 4/7/2004 telephone conference between Examiner Draper and Attorney Rooy, the current Abstract is acceptable.

The following remarks are directed to Page 2, Pars. 4 and 5 of the Office Action mailed

11/13/2004:

The Oxford dictionary defines ‘extreme’ to mean “outermost, furthest from the center, endmost, situated at either of the ends of a line, series or scale. *See The Compact Edition of the Oxford English Dictionary* pg. 941 Vol. I A-O (Oxford University Press 1971). The term “extreme” in the instant patent application is used in accordance with this meaning, that is, synonymous with “end”. Therefore, as agreed during the 4/7/2004 telephone conference between Examiner Draper and Attorney Rooy, the existent wording of claims 4 – 7, 11 - 14 and 18 – 20 is acceptable.

The following remarks are directed to Page 3, Par. 1 – Page 5 Par. 1 of the Office Action mailed

11/13/2004:

Claims 1, 8 and 15 should be allowed because they are non-obvious.

Claims 1, 8 and 15 should be allowed because they are non-obvious. No motorized trikes equipped with airbags are disclosed in the prior art cited. In addition, the secondary indicia discussed below indicate these claims are non-obvious.

The Court of Appeals for the Federal Circuit has elevated secondary considerations to the same level as the three factual considerations listed in Deere. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050, 5 U.S.P.O.2d 1434 (Fed.Cir.), cert. denied, 488 U.S. 825, 109 S.Ct. 75, 102 L.Ed.2d 51 (1988). The Court of Appeals for the Federal Circuit has held that if present,

evidence rising out of secondary considerations must always be considered in nonobviousness determinations, and it is error to exclude that evidence from consideration. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 1539, 218 U.S.G.Q. 871 (Fed.Cir. 1983). The Stratoflex court went further to say:

Indeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decision maker remains in doubt after reviewing the art. *See Id.*

In this case a number of secondary considerations indicate the instant invention is nonobvious. There has been a long-felt but unsolved need for a trike rear suspension which provides automatic frame leveling, more comfort, and better handling than conventional trike suspensions. In addition, Applicant's sales have increased dramatically since introducing the instant invention, in spite of reducing his advertising budget. This record of commercial success indicates the instant invention is nonobvious.

I. Long Felt But Unsolved Needs.

Long felt but unsolved needs may be relevant in the determination of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 U.S.P.Q. 459 (U.S. 1966). Firms characteristically try to increase product quality and production. *See Kitch, Graham v. John Deere Co.: New Standards for Patents*, 1966 Sup.Ct.Rev. 293, 332. If the Applicant's innovation had been obvious, then other workers skilled in the industry would have adopted Applicant's invention earlier. *Id.*

One problem associated with modern trikes is keeping the motorcycle frame at the correct angle relative to the surface upon which the trike rests. It is important to maintain the motorcycle frame at the correct angle relative to the surface upon which the trike rests in order to optimize the handling characteristics and ride comfort of the trike. This problem arises especially when drivers of different weights occupy the front seat, or when a passenger climbs into the rear seat. Although front-to-rear leveling arrangements have been taught within the art for conventional two-wheel motorcycles, Applicant is not aware of the existence of any such systems which are usable on trikes.

The instant invention provides an automatically adjustable rear suspension for trike which maintains the motorcycle frame at the correct angle relative to the surface upon which the trike rests.

Another problem associated with currently available trikes is a phenomenon known as pushback. Pushback is the reaction of the motorcycle steering wheel to bumps which the rear wheels see. For example, if the left rear wheel hits a bump, then the front wheel will tend to veer right due to pushback. Conversely, if the right rear wheel hits a bump, then the front wheel will tend to veer left. The instant invention provides an automatically adjustable rear suspension for trike which minimizes pushback by use of air springs. Shock absorbers do not work as well, because they tend to be too stiff, especially air shocks. The softer spring constant of air springs tends to absorb bumps better, and thus minimizes pushback.

Over the years, others in the industry have attempted save these problems. One approach has been to decrease the front fork angle to the horizontal , but this fix didn't work because if somebody got into the rear, the frame angle would change. *See Declaration of Larry L. McGuire* Par. 8. In addition, the oversteer caused by this configuration severely reduces the life of the front tire. *Id.*

If the Applicant's innovation had been obvious, then other workers skilled in the industry would have adopted Applicant's invention earlier. As explained above, they tried, but were unable to come up with Applicant's novel and non-obvious design. This absence of success indicates Applicant's automatically adjustable rear suspension for trike is non-obvious.

II. Commercial Success

Commercial success of the invention may be relevant in the determination of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 U.S.P.Q. 459 (U.S. 1966). A chain of four inferences underlie this test: 1. The commercial success is due to innovation; 2. If an improvement has become commercially successful, it is likely that this potential success was perceived before its development; 3. Given that the possibility for commercial success was envisioned, it is likely that efforts were made within the industry to develop the improvement; and 4. Efforts having been made within the industry, they failed because the patentee was the first to reduce his development to practice. *See Kitch, Graham v. John Deere Co.: New Standards for Patents*, 1966 Sup.Ct.Rev. 293, 332. These will be considered below in turn.

1. The commercial success is due to the innovation.

The CAFC requires a “nexus” between the commercial success and the nonobviousness. *See Windsurfing Int’l., Inc. v. AMF, Inc.*, 782 F.2d 995, 228 U.S.P.Q. 562 (Fed.Cir.), cert. denied, 477 U.S. 905, 106 S.Ct. 3275, 91 L.Ed.2d 565 (1986). In the instant case, Applicant’s success was due to his innovative invention.

The automatically adjustable rear suspension for trike has been very well accepted, and within four months of the design’s introduction all of Applicant’s sales were the improved design. *See Declaration of Larry L. McGuire* Par. 10. Sales were so good, that Applicant reduced his print advertising about 50%, yet Applicant’s 2003 sales were up 20% compared with 2002 sales, and 2004 are forecast to increase an additional 20%. *Id.* at Par. 11.

The increased sales are not due to increased advertising, as explained above, nor to Applicant’s position in the market – Applicant is only one of several companies which performs trike conversions. *Id.* at Par. 9. Applicant’s trade show participation has remained approximately constant since the introduction of the automatically adjustable rear suspension for trike invention, and all Applicant’s other advertising and promotion have remained approximately constant since the introduction of the automatically adjustable rear suspension for trike invention. *Id.* at Par. 12.

Nor is Applicant’s commercial success due to price reductions - prices have actually increased approximately 10% with the introduction of the automatically adjustable rear suspension for trike.

Id. at Par. 10. Rather, the reason Applicant's automatically adjustable rear suspension for trike invention sells so well is because of its better ride and steering characteristics as compared to conventional rear trike suspensions. Id. at Par. 12.

2. If an improvement has become commercially successful, it is likely that this potential success was perceived before its development.

Ride and steering characteristics are very important considerations in the customers mind when deciding what trike suspension to choose. Id. At Par. 19. Applicant's competitors have attempted to solve the pushback and frame leveling problems for years, unsuccessfully. Id. Therefore both the problem, and the likelihood of reward in the marketplace, have long been recognized in the industry. Id.

3. Given that the possibility for commercial success was envisioned, it is likely that efforts were made within the industry to develop the improvement.

Attempts have been made within the industry over the last ten years to manufacture faster closing lariats. Id. At Pars. 8, 17.

One approach has been to decrease the front fork angle to the horizontal , but this fix didn't work because if somebody got into the rear, the frame angle would change. *See Id.* Par. 8. In addition, the oversteer caused by this configuration severely reduces the life of the front tire. Id. So the problem has been recognized within the industry for a long time, and no effective solution existed until Applicant's Improved Lariat. Id.

4. Efforts having been made within the industry, they failed because the patentee was the first to reduce his development to practice.

The problem has been recognized within the industry for a long time, and no effective solution existed until Applicant's automatically adjustable rear suspension for trike. Id. At Par. 5, 19. The reason Applicant's automatically adjustable rear suspension for trike invention sells so well is because it affords trike passengers better ride and handling than conventional trike rear suspensions. Id. at Par. 12, 18. The handling and ride provided by my automatically adjustable rear suspension for trike invention makes it the best competitive trike suspension design on the market *See Id.* at Par. 18.

Therefore, because: 1. Applicant's commercial success was due to innovation; 2. The potential success for was perceived by the industry before Applicant's invention; 3. Efforts were made within the industry to develop the improvement; and 4. These efforts failed because Applicant was the first to reduce his development to practice, the instant invention is non-obvious due to its commercial success.

III. Conclusion.

Because Applicant's improved automatically adjustable rear suspension for trike fills long felt but unsolved needs within the industry, and because of the commercial success of Applicant's improved automatically adjustable rear suspension for trike, the instant invention is not obvious, and a patent should be issued for Applicant's improved automatically adjustable rear suspension for trike.

Currently amended independent claims 2, 9 and 16 should be allowed for claimed features lacking in the cited references.

None of the references cited incorporate the instant invention L arm. The instant L arm permits the air spring to be located directly over the axle, in its most effective position. This is important to provide a more comfortable ride to the passengers. *See Declaration of Larry L. McGuire* Par. 15. Considerable design and development work was required to finalize the design on the L arm configuration so as to place the air spring in the required location. *Id.* Par. 16.

The prior art cited lacks the instant L arm as claimed in claims 2, 9 and 16. Therefore, these claims should not be rejected under 35 U.S.C. § 103 because the references cited do not teach the instant L arm.

In addition, 2, 9 and 16 are non-obvious because Applicant's improved automatically adjustable rear suspension for trike fills long felt but unsolved needs within the industry, and because of Applicant's commercial success with the improved automatically adjustable rear suspension, as explained above and supported by Applicant's Declaration.

As was agreed during the 4/7/04 telephone conference between Examiner Draper and Attorney Rooy, the accompanying Amendment casts claims 2, 9 and 16 in independent form, incorporating all the limitations of their base claims, and each of these claims the instant L arm, which is novel

and non-obvious for the reasons set forth above. Therefore, it is anticipated claims 2, 9 and 16 are now in condition of allowability.

**FEE FOR RESPONSE WITHIN THE THIRD MONTH, AND FOR
AN ADDITIONAL THREE INDEPENDENT CLAIMS**

Checks totalling \$604 to "Commissioner for Patents" are herewith submitted: \$475 for response within the third month, plus \$129 for the extra three independent claims at \$43 each.

CONCLUSION

Applicant requests reconsideration and withdrawal of the rejections. Per the 4/7/2004 telephone conference between Examiner Draper and Attorney Rooy, Examiner Draper graciously offered to call Attorney Rooy after reviewing this Amendment and Remarks to resolve any details standing in the way of approval of those claims that are substantially in condition of allowability as a result of the accompanying arguments and Amendment.

Respectfully submitted,



Paul S. Rooy
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I hereby certify this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22213-1450 on 4/14/2004.

Signed Lamont L. Poole
Reg. No. 35,338

Date 4/14/2004